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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,138	07/11/2001	David P. Greene	I01.022	9671
48175	7590	09/20/2005	EXAMINER	
BMT/IBM FIVE ELM STREET NEW CANAAN, CT 06840			SWEARINGEN, JEFFREY R	
			ART UNIT	PAPER NUMBER
			2145	
DATE MAILED: 09/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/903,138

Applicant(s)

GREENE ET AL.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21-27, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21-27, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This case has been assigned to a new Examiner.

***Claim Objections***

2. Claim 16 is objected to because of the following informalities: Several clauses of claim 16 are grammatically incorrect. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has not given adequate explanation of what an "attention unit" or a "criterion" actually is in order to enable one of ordinary skill to implement the invention. For purposes of compact prosecution, the Examiner is treating "attention units" as a billing function and "criterion" as an attribute of a voice call.

5. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The clause *arranging for the receiving party to respond to the second communication before responding to the first communication because the second amount is greater than the first amount* has not been previously mentioned in the specification and constitutes new matter for this amendment.

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6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "attention units" and "criterion" in all of the claims is indefinite because the specification does not clearly redefine the term. Page 6 of the disclosure gives a definition of "attention units" that the Examiner interprets to mean a number. The use of a number is indefinite. For purposes of compact prosecution, the Examiner is treating "attention units" as a billing function. Pages 7-8 talk about using a "criterion", but never give a clear definition of what a "criterion" is. The Examiner is treating "criterion" as an attribute of a voice call for purposes of compact prosecution.
8. Claim 15 recites the limitation "said plurality of entities" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:
- Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
10. Claims 1-19, 21-27, and 31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
11. Claims 1-19 and 21-27 are broad method claims that do not recite any computer hardware. The method steps given in claims 1-19 and 21-27 can be performed by non-statutory material, such as a person keeping track of "attention units" by using a pencil to mark "attention units" on a piece of paper and erasing "attention units" as they are used. An email message can be present on a piece of paper

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and an "attachment" to be opened can be an envelope stapled to the email message – no computer or computer hardware has been claimed. Applicant has not claimed the use of a telephone for a telephonic call or voicemail messaging. The Examiner must give the broadest possible interpretations to the claims, and the claims are read in light of the specification, but limitations from the specification cannot be read into the claims.

12. In regard to claim 31, Applicant has not listed a "computer program product" within the specification. For purposes of compact prosecution, the Examiner is treating page 25 of the specification as the embodiment of a "computer program product". Within that definition, Applicant states that the software CAN BE stored on tangible media. Stating that software CAN BE stored on tangible media DOES NOT LIMIT storage to tangible media. Therefore, the software CAN BE stored on intangible media, and the claim is non-statutory. Software should be stored on tangible, computer readable media. The claims and specification should be amended appropriately to overcome this rejection.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1 rejected under 35 U.S.C. 102(e) as being anticipated by Sponaugle et al. (U.S. Patent No. 6,865,161).

15. In regard to claims 1, 30, and 31, Sponaugle discloses *associating a total number of attention units to a first entity; allowing said first entity to provide a first communication to a second entity, wherein said first communication is associated with a first criterion and a first amount of attention units; reducing the total number of attention units by the first amount when said first criterion is satisfied; allowing said*

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*first entity to provide a second communication, wherein said second communication is associated with a second criterion and a second amount of attention units, the second amount being different than the first amount; and reducing the total number of attention units by the second amount when said second criterion is satisfied, wherein the second entity is to respond to the first communication based at least in part on the first amount of attention units.* Sponaugle describes a method of making voice calls between entities on the internet, or *allowing first entity to provide a communication to a second entity.* See Sponaugle, column 6, lines 33-67. *Associating a total number of attention units to a first entity and reducing the total number of attention units by an amount* is detailed in Sponaugle, column 5, lines 41-44, which shows a per use fee being billed to the call originator for making a voice call. The implementation of a second communication is merely using Sponaugle twice consecutively to make two voice calls, and billing for each voice call in turn to a single account.

16. In regard to claim 2, Sponaugle is applied as in claim 1. Sponaugle further discloses *said first communication comprises an email message.* The email embodiment of Sponaugle is taught in column 8, line 62 – column 9, line 55.

17. In regard to claim 3, Sponaugle is applied as in claim 2. Sponaugle further discloses *at least one of the following: satisfying a request included in said first communication; said second entity receiving said email message; said second entity opening said email message; said second entity opening an attachment to said email message; said second entity responding to said email message; said second entity saving said email message; and said second entity forwarding said email message.* Sponaugle discloses an email embodiment for making voice calls. This is *satisfying a request included in said first communication.* See Sponaugle, column 8, lines 62 – column 9, line 55.

18. In regard to claim 8, Sponaugle is applied as in claim 1. Sponaugle further discloses *said first communication comprises a telephone call.* See the rejection for claim 1, which details how Sponaugle teaches the creation of voice calls.

19. In regard to claim 9, Sponaugle is applied as in claim 8. Sponaugle further discloses *said first criterion includes at least one of the following: satisfying a request included in said first communication; said second entity receiving telephone call; said second entity answering said telephone call; and said*

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*second entity responding to said telephone call. As taught in Sponaugle, column 6, lines 33-67, a voice (telephone) call is made between two recipients. A second entity receiv[es] said telephone call.*

20. In regard to claim 10, Sponaugle is applied as in claim 1. Sponaugle further discloses *preventing the first entity from associating more than the total number of attention units with a communication.*

Sponaugle in column 8, lines 4-24, and Figure 3f, discloses an accounting system based upon a fee. In either a credit card or account setting as shown in Figure 3f – which are merely possible billing options according to Sponaugle, column 8, lines 22-24 and are not limited to such billing options – it is inherent to such systems that a user cannot spend more than the amount they are allocated. Using a fee based service when such methods are in use would be suspended if the user's accounts had become overdrawn or insufficient funds existed in said accounts.

21. In regard to claim 12, Sponaugle is applied as in claim 1. Sponaugle further discloses *allocating a plurality of attention units among a plurality of entities, said plurality of entities including said first entity and said second entity, wherein each of said entities in said plurality of entities is allocated zero or more attention units, wherein said allocating includes said associating said total number of attention units to said first entity.* Applicant has herein claimed that each entity among the plurality of entities can have zero attention units. This is interpreted to read that each entity has not paid for the use of the service yet, and has not used the service. As previously shown in Sponaugle, and in column 8, line 4-24, Sponaugle is a fee-based service. If no fee has been paid, then the service cannot be used. A fee has been defined as *attention units*. No attention units or zero attention units means that a fee has not been paid, or the entities are not using the service.

22. In regard to claim 13, Sponaugle is applied as in claim 12. Sponaugle further discloses *allowing an entity from said plurality of entities to acquire additional attention units.* Sponaugle in column 8, lines 4-24 describes a fee-based service. Paying a fee for use of the service is *acquiring additional attention units*.

23. In regard to claim 14, Sponaugle is applied as in claim 12. Sponaugle further discloses *evaluating an entity from said plurality of entities based, at least in part, on a number of attention units associated with said entity.* As shown in figure 3F, Sponaugle grants accounts as a billing option for

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entities. Checking the account balance – an inherent part of a billing mechanism using an account – is *evaluating an entity based on a number of attention units associated with said entity.*

24. In regard to claim 15, Sponaule is applied as in claim 1. Sponaule further discloses *providing a benefit to an entity from said plurality of entities based, at least in part, on a number of attention units associated with said entity.* As shown in column 5, lines 41-44 and column 6, lines 33-67, Sponaule details making a voice call and billing for said voice call. Billing is *based, at least in part, on a number of attention units associated with said entity.* The voice call is *providing a benefit to an entity.*

25. In regard to claim 16, Sponaule is applied as in claim 1. Sponaule further discloses *at least one of the following: establishing a maximum number of attention units can (sic) be associated with said first entity; establishing a maximum number of attention units that can be acquired by said first entity; establishing a maximum number of attention units that can be loaned by said first entity; establishing a maximum number of attention units that can be borrowed by said first entity; establishing a maximum number of attention units that can be sold by said first entity; establishing a maximum number of attention units that can be purchased by said first entity; establishing a maximum number of attention units that can be transferred by said first entity; establishing a maximum number of attention units that can be earned by said first entity; establishing a maximum number of attention units that can be used by said first entity during a time period; establishing a maximum number of attention units that can be used by said first entity for said communication; providing a notification indicative of a maximum number of attention units that can be used with said first communication; providing a notification indicative of a maximum number of attention units that can be used by said first entity; establishing a minimum number of attention units can (sic) be associated with said first entity; establishing a minimum number of attention units that can be acquired by said first entity; establishing a minimum number of attention units that can be loaned by said first entity; establishing a minimum number of attention units that can be borrowed by said first entity; establishing a minimum number of attention units that can be purchased by said first entity; establishing a minimum number of attention units that can be transferred by said first entity; establishing a minimum number of attention units that can be earned by said first entity; establishing a minimum number of attention units that can be used by said first entity during a time period; establishing a minimum number*



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*of attention units that can be used by said first entity for said communication; providing a notification indicative of a minimum number of attention units that can be used with said first communication; and providing a notification indicative of a minimum number of attention units that can be used by said first entity.* Applicant has claimed basic accounting procedures. Sponaugle as taught in column 8, lines 4-24 details a billing service for payment of fees for making voice calls. Sponaugle shows the presence of an account in Figure 3f. The establishment of maximum or minimum values would be designated by the establishment of a fee. Checking the account balance – an inherent portion of an accounting system – is *providing a notification indicative of a maximum or minimum amount of attention units that the user may use/transfer/purchase/sold/etc.*

26. In regard to claim 17, Sponaugle is applied as in claim 1. Sponaugle further discloses *at least one of the following: receiving data indicative of said total number of attention units; receiving a communication from said first entity, wherein said communication includes data indicative of said total number of attention units; establishing a minimum number of attention units that can be associated with said communication; and establishing a maximum number of attention units that can be associated with said communication.* Applicant has claimed basic accounting procedures. Sponaugle as taught in column 8, lines 4-24 details a billing service for payment of fees for making voice calls. Sponaugle shows the presence of an account in Figure 3f. The establishment of maximum or minimum values would be designated by the establishment of a fee. Checking the account balance – an inherent portion of an accounting system – is *receiving data indicative of a total number of attention units.*

27. In regard to claim 18, Sponaugle is applied as in claim 1. Sponaugle further discloses *said first criterion is associated with said first communication by default.* As previously shown, Sponaugle is a fee-based system for making voice calls. A criterion is associated with a call by establishing that the call needs to be made in the Sponaugle system. Various settings would be criterion such as shown in the screens illustrated in Figures 3A-3F.

28. In regard to claim 21, Sponaugle is applied as in claim 1. Sponaugle further discloses *establishing an expiration date for at least a portion of said total number of attention units.* Figure 3f

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details a billing system for Sponaule, including a credit card billing method with a credit card expiration date.

29. In regard to claim 23, Sponaule is applied as in claim 1. Sponaule further discloses *receiving a notification of a completion of said first criterion*. Figures 3A-3F show entry screens for entering attributes to make a voice call. Making the voice call would be a *notification of a completion of said first criterion*.

30. In regard to claim 24, Sponaule is applied as in claim 1. Sponaule further discloses *receiving a notification of a dispute regarding completion of said first criterion*. Figures 3A-3F show entry screens for entering attributes to make a voice call. Failure to make the voice call would be a *notification of a dispute regarding completion of said first criterion*.

31. In regard to claim 25, Sponaule is applied as in claim 1. Sponaule further discloses *at least one of the following: establishing an exchange for the transfer of attention units; allowing said first entity to run a deficit number of attention units; allowing said first entity to earn at least one attention unit; allowing said first entity to purchase at least one attention unit; allowing said first entity to sell at least one attention unit; allowing said first entity to lend at least one attention unit; allowing said first entity to transfer at least one attention unit; allowing said first entity to acquire control of at least one attention unit; and allowing said first entity to transfer control of at least one attention unit*. Sponaule in column 8, lines 4-24 details a billing system, or *an exchange for the transfer of attention units*.

32.

### ***Claim Rejections - 35 USC § 103***

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sponaule in view of Marchbanks et al. (U.S. Patent No. 6,266,401).

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35. In regard to claims 6-7, Sponaule is applied as in claim 1. Sponaule fails to disclose billing for the use of voice mail. However, Marchbanks in the analogous art of billing for communications teaches billing for both voice calls and voicemail. See Marchbanks, column 3, lines 42-50. Therefore it would be obvious to one of ordinary skill in the art that since Marchbanks allows for additional types of telecommunications billing options, and since Sponaule teaches a basic method of billing for telecommunications, that one would be motivated to use the voicemail billing option taught in Marchbanks with the Sponaule invention for the purpose of commercial success and to reach out to new customers using voicemail in addition to voice calls.

36. In regard to claim 22, Sponaule is applied as in claim 1. Sponaule fails to disclose tracking the number of "attention receipt units". However, Marchbanks, in the analogous art of billing for telecommunications over the Internet, teaches a call detail billing record (Figure 3). This is *maintaining a count of attention receipt units associated with said second entity*. Since Sponaule teaches billing for voice calls, and Marchbanks teaches call detail on billing for calls, it would be obvious to one of ordinary skill in the art to combine the Sponaule invention with the teachings of Marchbanks for the purpose of allowing the user to keep track of his account activity.

37. Claims 4-5, 11, 19, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sponaule.

38. In regard to claims 4-5, Sponaule is applied as in claim 1. Sponaule fails to disclose that a communication can be a meeting request. However, a voice call in Sponaule can be made for any purpose, including the caller requesting a meeting with the sender. Therefore it would be obvious for one of ordinary skill in the art to request meetings using voice calls in the Sponaule invention.

39. In regard to claim 11, Sponaule is applied as in claim 1. Sponaule has shown associating a criterion with a communication, or setting parameters for making a voice call. Sponaule gives functionality for one user to make many voice calls. It would be obvious to one of ordinary skill in the art that Sponaule could be used to make two separate phone calls to different entities by changing the phone number, or *the second criterion is different than the first criterion*.

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40. In regard to claim 19, Sponaule is applied as in claim 1. Sponaule fails to disclose *increasing said second entity's attention units by the first amount*. However, it would be obvious to one of ordinary skill in the art that a user could call anyone, including the service provider. Calling the service provider and getting charged for it would be *increasing said second entity's attention units by the first amount*.

41. In regard to claims 26-27, Sponaule is applied as in claim 1. Users can decide whether to select a call based upon the preferences of the call. If a receiving party receives two calls and notices that one is long distance or more important (a greater amount of attention units), the receiving party can respond to the more important long distance call before the lower priority call. Therefore it would be obvious to one of ordinary skill in the art for a receiving party using the Sponaule invention to select which call to select based upon priority. It would be further obvious for one of one of ordinary skill in the art to allow the recipient to be the service provider. Calling the service provider and getting charged for it would be *increasing a third total number of attention points associated with the receiving party when the receiving party responds to the second communication, wherein said increasing is based at least in part on the second amount*.

### ***Response to Arguments***

42. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

43. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH**

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shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER